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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/147,237	04/20/99	YAGI E	TOS-123-USA

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EXAMINER	
PRATS,F	
ART UNIT	**PAPER NUMBER**
1651	14

DATE MAILED: 06/22/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Advisory Action

Application No.	Applicant(s)
09/147,237	Eiichiro Yagi et al
Examiner	**Group Art Unit**
Francisco C. Prats	1651

THE PERIOD FOR RESPONSE: [check only a) or b)]

a) ☒ expires 3 months from the mailing date of the final rejection.

b) ☐ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

☐ Appellant's Brief is due two months from the date of the Notice of Appeal filed on _____ (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on Jun 12, 2000 has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:

☒ The proposed amendment(s):

☐ will be entered upon filing of a Notice of Appeal and an Appeal Brief.

☒ will not be entered because:

☒ they raise new issues that would require further consideration and/or search. (See note below).

☐ they raise the issue of new matter. (See note below).

☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.

☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: see attachment

☐ Applicant's response has overcome the following rejection(s):

☐ Newly proposed or amended claims _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.

☒ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:
see attachment

☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):

Claims allowed:

Claims objected to:

Claims rejected: 1-4 and 15-18

☐ The proposed drawing correction filed on _____ ☐has ☐has not been approved by the Examiner.

☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). _____ .

☐ Other

FRANCISCO C. PRATS
PRIMARY EXAMINER
ART UNIT 1651

ATTACHMENT TO ADVISORY ACTION

1. The text of those sections of Title 35, U.S. Code, not included in this action can be found in a prior office action. The after-final amendment filed June 12, 2000, has been received, but will not be entered because it raises new issues for search and consideration. Specifically, the recitations "before or during exposure to ultraviolet light" and "consisting essentially of" raise new issues for search and consideration. Since these terms clearly require a new search and consideration in light of the prior art, it is respectfully submitted that denial of entry is proper at this stage of prosecution.

2. All of applicant's argument has been fully considered but is not persuasive of error. It is noted initially that all of applicant's argument assumes entry of the amendment which has not been entered, as discussed above. In view of the non-entry of the amendment at issue, it is respectfully submitted that the rejections of record remain required.

However, applicant's argument is persuasive to the extent that ***if*** the amendment at issue were enterable, the rejections under § 112, first and second paragraphs, would have to be dropped. Moreover, based on applicant's argument, none of the

pending prior art rejections would be tenable either, ***if*** the amendment were enterable. However, the claims as amended in the after-final amendment at issue were not before the examiner at the time of the final rejection. Thus, the examiner has not had the opportunity to examine the newly claimed limitations and determine whether they would be patentable over all available prior art, and not just the art currently applied over different claims.

Moreover, the Oyama reference would arguably be applicable under § 103(a), since one of ordinary skill would have reasonably expected the UV protection effects to have occurred upon pre-UV or during-UV administration of the glutathione-containing compositions disclosed therein. Further still, although Oyama includes kojic acid and/or derivatives in his compositions, there is no evidence that those compounds would in any way affect the basic and novel properties of the glutathione. Thus, on the current record, the proposed "consisting essentially of" language would not differentiate the claims from Oyama.

In sum, it is conceded that if amended as proposed, the pending grounds of rejection would have to be dropped. However, it is respectfully submitted that the Oyama reference would arguably remain applicable under § 103(a), as discussed above.

Moreover, the amendment at issue is properly denied entry at this stage of prosecution because of a lack of previous opportunity for search and consideration of the new limitations. Thus, it is not clear that different prior art encountered in the newly required search would not be applicable to the claims if amended as proposed.

3. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to F.C. Prats whose telephone number is (703) 308-3665.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Michael G. Wityshyn, can be reached on (703) 308-4743.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Communications applicant wishes to submit by FAX should be submitted to FAX # (703) 305-4242 or (703) 305-3014.

FRANCISCO C. PRATS
PRIMARY EXAMINER
ART UNIT 1651

F.C. Prats
June 21, 2000